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09/605,056	06/28/2000	Kouhei Koyama	P107344-00003	6772

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RADER FISHMAN & GRAUER PLLC
LION BUILDING
1233 20TH STREET N.W., SUITE 501
WASHINGTON, DC 20036

EXAMINER

COLAIANNI, MICHAEL

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 12/24/2002

16

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.
09/605,056

Applicant(s)

Koyama et al.

Examiner
Michael Colaanni

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1731



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on Oct 23, 2002

2b) ☐ This action is non-final.

2a) ☒ This action is FINAL.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 1-14 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 1-14 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) ☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☒ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☒ Certified copies of the priority documents have been received in Application No. 08/726,175

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

a) The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s).

4) ☐ Interview Summary (PTO-413) Paper No(s).

5) ☐ Notice of Informal Patent Application (PTO-152)

6) ☐ Other:

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Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 1, 9 and 12 refer to "of axial engaging portions" in the second to last line of the claims which is of confusing antecedent basis with the "frictional engaging portions" earlier in the claim. Are not the "axial engaging portions" the "frictional engaging portions"?

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 9-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Ono et al.

5430904.

Ono et al. teach applicant's claimed invention comprising: a case having shape and dimensions to be held and manipulated by one hand (col. 6, lines 45-55); a feed reel rotatably

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provided in the case and winding a coat film transfer tape (col. 11, lines 33); a take-up reel rotatably provided in the case and collecting the coat film transfer tape after use (col. 11, line 35); an interlock means for linking said feed and take-up reels so as to cooperate with each other (col. 11, lines 41), and a coat film transfer head protruding at a front end of the case and pressing the coat film transfer tape onto an object of transfer (col. 6, line 49); a clutch means for synchronizing, at least in one of the feed and take-up reels a feed, a feed speed and take-up speed of the coat film transfer tape between the feed and take-up reels; wherein the clutch means composes, at least in one of the feed and take-up reels, power transmission means provided between a tape winding portion for winding up the coat film transfer tape and a rotary drive unit for rotating and driving the tape winding portion (col. 11, lines 41-54), and is composed by frictionally engaging with each others frictional engaging portions formed in confronting axial end surfaces of the tape winding portion and the rotary drive unit (Figure 12, ref. nos. 7, 8, 10 and col. 11, lines 45-51); and wherein there is no axial movement of the tape winding portion and the rotary drive unit relative to each other during rotation of the tape winding portion and the rotary drive unit (col. 12, lines 38-55, the slip ring and feed core are biased against one another by the spring; the spring prevents axial movement); and wherein power transmission means is from a frictional force caused by a thrust load between the tape winding portion and the rotary drive unit, and is connected and disconnected by a difference in torque therebetween, the thrust load, which causes the frictional force, is set by predetermined relational dimensions of the tape winding portion and the rotary drive unit in the axial direction between the tape winding portion and the rotary drive unit (col. 11, lines 41-54, the thrust force between the members 7 and 8 controls the

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amount of torque supplied to the feed reel) defined by direct and axial engaging of axial engaging portions formed in the tape winding portion and the rotary drive unit (col. 11, lines 41-54, the thrust force between the members 7 and 8 controls the amount of torque supplied to the feed reel. Also the "direct and axial engagement" claimed does not preclude using a spring to biased the tape winding portion and the rotary drive unit together).

Ono et al. also teaches claim 12 (col. 11, lines 31-59).

Ono et al. further teach that the tape rewinding means of claim 15 has an axial free end and the rewinding operation unit is integrally formed at the end surface of the free end (Fig. 3, ref. no. 9 and 1c). Also, Ono et al. teach that the clutch mechanism is placed in both the feed reel and take-up reel (Fig. 16, ref. nos. 9, 7 and 10).

5. Claims 1-2 and 8 are rejected under 35 U.S.C. 102(b) as being anticipated by Ono et al. 5430904.

Ono et al. teaches applicant's claimed invention of a clutch mechanism for a film transfer tool having a feed reel and a take-up reel rotatably provided in a hand-held case the two reels being synchronized (col. 6, lines 45-55; col. 11, lines 33, 35), power transmission means between the tape winding portion for winding-up the coat film and a rotary drive unit for rotating and driving the tape winding portion, the power transmission means being composed by frictionally and directly engaging with each other engaging portions formed in confronting axial end surfaces of the tape winding portion and the rotary drive unit (Figure 12, ref. nos. 7, 8, 10 and col. 11, lines 45-51) and wherein the power transmission means is from a frictional force caused by a

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thrust load between the tape winding portion and the rotary drive unit and is connected and disconnected by a difference in torque therebetween, the thrust load, which causes the frictional force, is set by predetermined relational dimensions of the tape winding portion and the rotary drive unit in the axial direction between the tape winding portion and the rotary drive unit (col. 11, lines 41-54, the thrust force between the members 7 and 8 controls the amount of torque supplied to the feed reel) defined by direct and axial engaging of axial engaging portions formed in the tape winding portion and the rotary drive unit (col. 11, lines 41-54, the thrust force between the members 7 and 8 controls the amount of torque supplied to the feed reel. Also the "direct and axial engagement" claimed does not preclude using a spring to biased the tape winding portion and the rotary drive unit together).

Ono et al. also teach that the the first and second engaging surface is in the shape of annular ribs (Fig. 15, ref. no. 15; here "annular" has been interpreted to mean ribs arranged in the shape of a ring, which is taught by Ono et al.).

Ono et al. also teaches using a position defining unit for suppressing distance between axial end surfaces of the tape winding portion and the rotary drive unit (Fig. 2, ref. no. 11, the spring 11 maintains the force between the clutch plate 8 and tape winding portion 7).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are

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such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 3-7 are is rejected under 35 U.S.C. 103(a) as being unpatentable over Ono et al. 5430904.

Ono et al. substantially teaches applicant's claimed invention. See the above 35 U.S.C. §102(b) rejection above for Ono et al.'s teachings. However Ono et al. do not explicitly teach the various combinations of flat and ribbed frictional surfaces as claimed in claims 3-7.

However, Ono et al. teach that using a flat surface in combination with a ribbed surface is well known in the film transfer tool clutch mechanism art (Fig. 12, ref. nos. 7, 8, 10 and 12). Thus, using the various claimed combinations of a flat surfaces and ribbed surfaces to achieve the clutch action that is desired would have been obvious in view of Ono et al.'s teachings.

Moreover, regarding claim 7 directed to using a flange with elasticity as part of the frictional engagement in the clutch mechanism, Ono et al. does teach a series of raised ridges that form a square pattern surrounds the reel and support the slip ring (Fig. 15, ref. no. 12 and 15). These raised ridges serve the same purpose as the raised flange and changing the shape of the

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ridges from a square shape to a circular shape is deemed an obvious design choice.

It would have been prima facie obvious at the time the invention as made to combine the various clutch surfaces and an annular elastic flange with Ono et al.'s transfer film clutch mechanism for the reasons given in the body of the rejection and because the choice of shape of the engagement surfaces has no bearing on the strength or other characteristics of the device, so the particular choice is also merely an obvious design choice.

Response to Arguments

9. Applicant's arguments filed October 23, 2002 have been fully considered but they are not persuasive.

Applicant argues that the Ono et al. do not teach a power transmission means that is composed by frictionally and directly engaging with each others frictional engaging portions that are formed in confronting axial end surfaces of the tape winding portions and the rotary drive unit. The Examiner respectfully disagrees.

Ono et al. teaches that the power transmission means, the slip ring 10, is formed of a slip ring friction member (col. 7, lines 32-36). This friction member provides the necessary frictional force between the rotary drive unit 8 and the tape winding portion 7. Moreover, the frictional force is formed between axially and directly confronting ends of the members. The rejections are sustained.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time

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policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Colaianni whose telephone number is (703) 305-5493. The examiner can normally be reached on Monday to Friday from 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin, can be reached on (703) 308-1164. The fax phone number for this Group is (703) 305-7115.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0651.



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December 18, 2002

MICHAEL COLAIANNI
PRIMARY EXAMINER